

REMARKS

Claim Rejections

Claims 1-2 and 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fig. 1 of Prior Art, Applicant's admitted prior art in view of Park et al. (U.S. 2003/0143319 A1). Claims 3 and 4 are allowed.

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

New Claims

By this Amendment, Applicant has canceled claims 2, 5 and 6, amended claims 1 and 3, and added new claim 7 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Claim 3 has been amended to obviate the objections set forth in the outstanding Office Action. Claims 3 and 4 are allowed.

On page 3 of the outstanding Office Action, the Examiner admits that Applicant's admitted prior art "fails to teach a passivation layer is a multi-layer structure wherein each layer of the multi-layer structure is made of a different material."

Applicant's admitted prior art does not teach said multi-layer structure includes one silicon nitride layer with the thickness of approximately 3000 Å.

The secondary reference to Park et al. teaches a flat panel display device and is cited for teaching, page 4, paragraph 0056, "a passivation film may be formed with a multi-layer structure of the inorganic insulating film and the organic insulating film."

Park et al. do not teach said multi-layer structure includes one silicon nitride layer with the thickness of approximately 3000 Å.

Even if the teachings of Applicant's admitted prior art and Park et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: said multi-layer structure includes one silicon nitride layer with the thickness of approximately 3000 Å.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a

guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Applicant's admitted prior art or Park et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Applicant's admitted prior art nor Park et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new and amended claims.

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Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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